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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,957	05/31/2005	Dieter Buttau	49-004-TN	9934
23400	7590	08/01/2007		
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			EXAMINER ROSS, DANA	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 08/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/536,957

Applicant(s)

BUTTAU ET AL.

Examiner

Dana Ross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/31/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election with traverse of claims 1-9 in the reply filed on 16 July 2007 is acknowledged. The traversal is on the ground(s) that the product and process are not proper since 1) the product and process there is unity of invention between the tool-holding device and the method of positioning a tool in a chuck; 2) product and process restriction is improper under national phase applications; 3) the claimed inventions all involve the same or corresponding special technical features. This is not found persuasive because as stated in the Restriction requirement, Examiner maintains there is no unity of invention between the product and process and both can function independently of each other and do not require the limitations of each. The tool-holding device of claims 1-9 do not disclose the special technical features that define a contribution which each of the claimed inventions as a whole makes over the prior art. Furthermore, the method of positioning a tool of claims 10-17 do not disclose the special technical features that define a contribution which each of the claimed inventions as a whole makes over the prior art.

**The requirement is still deemed proper and is therefore made FINAL.**

Examiner notes that the elected claims 1-9 also contain claims directed towards various species of Applicant's invention. Examiner notes that Applicant asserts that there is a unity of invention and that the tool holding device is a "special construction". Though Examiner notes there are various claimed and disclosed Species, an election is not necessary at this time due to the lack of criticality to the embodiments presented in the arguments presented in Applicant's response to the Restriction requirement. Examiner bases the below Examination on that argued

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“special construction” of the tool holding device. However, since the claims are currently written in such broad terminology, without any criticality to the specific shapes of the structure, an election of species is not required at this time. However, as Applicant’s invention is further defined, it is noted that a Species Election may be forthcoming.

Claim 10-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 16 July 2007.

***General***

2. Examiner notes that the claims are replete with intended use language. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,716,173 (Matsumoto, hereafter ‘173).

‘173 teaches a tool holder with a tool-holding device (tapered collet 20) having a tool-locating region (see area of reference number 21 of figure 11) for at least partly locating the tool 23, a connecting region (see area of reference number 19 of figure 11 with holding element 18) for arranging on the tool chuck (holder body 8), a positioning opening 15 through which a positioning means can be placed against the tool arranged at least partly in the tool-locating region (see figure 11, col. 7, lines 9-43, for example).

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,286,042 (Laube).

Laube teaches a tool holding device (see area of reference number 30) for hold a tool on a tool chuck (see reference number 20), the tool holding device having a tool-locating region (see area of reference number 52 of figure 1) for at least partly locating the tool, a connecting region (see area between reference number 32 and 50 of figure 1) for arranging on the tool chuck, a positioning opening (see area of reference number 82 of figure 1) through which a positioning means can be placed against the tool arranged at least partly in the tool locating region (see figure 1); the connecting region (see reference number 32 of figure 1) has a shank for arranging

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in a location opening of the tool chuck 20 (see area of reference numbers 36, 40 and 42 of figure 1); a holding element including o-rings 160 and a movable sleeve 162.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,567,093 (Richmond) in view of Laube.

Richmond teaches a tool-holding device for holding a tool 18 on a tool chuck (see figure 1), having a tool-locating region (see area between reference numbers 16 and 24 of figure 1) for at least partly locating the tool, a connecting region (see area of reference number 16 of figure 1) for arranging on the tool chuck.

Richmond teaches an entrance 19 a positioning means that can be placed against the tool (see figure 2, for example which shows the tool 18 abutting against the area 19).

Richmond teaches a holding element (see reference numbers 26C, 26B, 24, 26a and 28 of figure 2) provided in the locating region with an o-ring 28 movably mounted (see figure 2); the connecting region has an inner wall for arranging around an outer wall of the tool chuck (see figure 2).

Richmond does not expressly disclose the well-known feature of the positioning means (such as a piston), which is used to position the tool located at least partly in the tool-locating region (claim 1) or the inner wall of the connecting region being tapered.

Laube teaches it is well known in the art to provide a positioning means (such as a piston) within the tool holder which can be placed against the tool and arranged at least partly in the tool-locating region (see figure 1, col. 2, lines 43-56, for example).

It would have been obvious to one having ordinary skill in the art to modify the generic tool positioning device as taught by Richmond to include the well known feature of a piston to position the tool at least partly in the tool-locating region for the purpose of providing for various machining depths and adjustments based on the machining operation required at the time of machining.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shape of Richmond to include whatever shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. Furthermore the use of various shaped connectors is notoriously well known in the machine tool art for the purpose of providing connections with different chucks and such connections are functional equivalents to Richmond's shape, and as such, it would be obvious, absent a statement of criticality, to substitute one known functional equivalent for another, depending for example on the availability of components at the time of assembly. Therefore because the use of connections of various shapes are well known in the art, the connecting region inner wall of being of various shapes as shown in the prior art and are art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the non tapered wall of the connecting region for a taper as is shown in various other tapers of Richmond's device.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laube.

Laube teaches all aspects of claim 4 as discussed above.

Laube teaches a movable sleeve 162 but does not expressly disclose the use of rollers for holding a tool in place.

Examiner notes that it is well known in the art to use various means of holding a tool in place, including heat shrink (see '173 discussed above), o-rings with movable sleeves as taught by Laube, and the use of roller elements. The well-known use of a rolling-element cage to hold a tool in place is evidenced by US Pat. Pub. 2003/0175088 (Matsumoto et al.).

Examiner further notes that there has been no criticality placed on any particular arrangement for holding the tool, but instead is relies on well known holding device configurations to hold the tool in place.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to us a rolling-element cage to hold the tool of Laube in place because Applicant has not disclosed that the specific well known feature of using a rolling-element cage provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill furthermore, would have expected Applicant's invention to perform equally well with the movable sleeve as taught by Laube because the purpose of the movable sleeve is to provide a tool-holding device for holding a tool on a chuck that provides for the correction of the tip of the tool.



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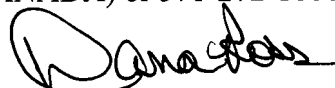
***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dana Ross  
Primary Examiner  
Art Unit 3722



dmr